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EXAMINER

SHANG, ANNAN Q

| | |
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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,783

Applicant(s)

NEWELL ET AL.

Examiner

Annan Q. Shang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9 and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/28/06 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-7, 9 and 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Horton et al (4,945,563)**.

With respect to Claim 1, **Russo** teaches a system for controlling use of broadcast content comprising a receiver in communications with a source of broadcast content and a playback device and a storage device, wherein the receiver is configured to extract the descriptor or supplemental information and control the use of the received broadcast content through the playback device

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and storage device in accordance with descriptor in the received broadcast content (fig.2, col.3 lines 3-28, lines 50-60, col.6 lines 12-25, col.8 lines 55-67). Russo teaches where a Storage Device (SD) 14 is coupled to Receiver (R) 4 (fig.1, col. 3 lines 3-20 and lines 40-64).

Furthermore, the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data. Russo teaches that descriptor information indicates the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content (col.6, lines 34-53, note that SD-14 receives and stores the program and "once the transaction has been registered by the record/play controller, relevant signal de-scrambling facilities would be enabled, allowing the program to be viewed") and once stored, a length of time that the received broadcast content may be consumed (col.5 lines 32-46, a viewer may be allowed to view the selected program as many times as desired over a particular time).

Russo further teaches that the descriptor or supplemental information may in the broadcast content path 102 (col.8 lines 65-67, col.9 line 1), but fails to explicitly state that this control information is embedded in the content and also defines the action or whether to store the received broadcast content prior to viewing.

However, Horton teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo with the ability to specify the action as storing the content and embedding descriptor information as in Horton in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs.

As to claim 4, Russo further teaches that the receiver is configured to maintain information relating to the use of the received broadcast content (col.3 lines 20-25, col.5 lines 48-65).

As to claim 5, Russo teaches that the receiver is configured to use the information relating to the use of the received broadcast content for remuneration of a provider of content (col.4 lines 45-67, col.5 lines 20-33, col.6 lines 34-55).

As to claim 6, Russo teaches that the information relating to the use of the received broadcast content comprises, a duration of use (col.5 lines 32-47).

As to claim 7, the claimed "method comprising..." is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 9, Russo teaches lengths of time and days that the broadcast may be viewed (col.5 lines 33-48), but fails to show that the descriptor information indicates the number of times the received broadcast content may be consumed. Limiting the number of times is a logical variation of the restriction of viewing already set forth by Russo and therefore would have been obvious to one of ordinary skill in the art at the time the invention was made. This would

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enable the broadcast facility to supply the viewer with various pricing and viewing options.

As to claim 12, Russo teaches that the video can be saved for a predetermined length of time but doesn't specifically state a date range (col. 5, lines 32-46). It is nonetheless inherent that this time period would be more than one day, thus covering a range of dates.

As to claim 13, it is inherent that the information sent to the user site would include billing information (col. 6 lines 10-27).

As to claim 14, it is inherent that the information sent to the user site would contain information for the cost of consuming the broadcast (col. 6 lines 10-27).

As to claim 15, Russo teaches the ability to "unlock" certain viewing options with a code sent along with the video stream (col. 6 lines 10-27). This inherently prevents the unjustified use of the broadcast material since other options would remain locked.

Regarding Claim 16, teaches shows obtaining payment information from the user (col. 6 lines 20-28, lines 35-46, col. 10 lines 10-48).

Regarding Claim 17, teaches shows communicating consumption information to a billing facility (col. 6 lines 34-53, col. 10 lines 10-48).

Regarding Claim 18, teaches shows that the billing facility comprises a facility maintained by a provider of the broadcast content (col. 6 lines 20-36).

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As to claim 19, the claimed “a machine-readable medium... a method comprising...” is composed of the same structural elements that were discussed in the rejection of claim 1.

As to claim 20, Russo further teaches where the storage comprises a memory accessible by a computer.

As to claim 21, Russo fails to show that the storage medium comprises a portable storage device. Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Russo with a portable storage device so that the instructions could be transported to other systems.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 4-7, 9 and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

With respect to amended independent claims 1, 7 and 19, Applicant argues that the prior arts of records **Russo (5,619,247)** and **Horton et al (4,945,563)**, fail to teach or suggest at least the feature, i.e., “the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing” of independent claims 1, 7 and 19. Applicant further argues that the combination of Russo and Horton is improper and no motivation to combine Russo and Horton

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In response, Examiner disagrees. Examiner notes applicant's arguments, however, Russo teaches sending the control data with the broadcast information (col.8 lines 65-col.9, line 1+, supplemental or control information, may be from program provider along path 102, using modulation/demodulation capabilities), and further teaches in col.5, lines 32-46 and col.6, lines 9-21 that storage device SD-14 receives and stores the program, and as discussed in the cited col., "once the transaction has been registered by the record/play controller, relevant signal de-scrambling facilities would be enabled, allowing the program to be viewed," which implies that the program is not reproduced prior to viewing until a transaction condition is met and furthermore teaches that once stored, a length of time that the received broadcast content may be consumed, which reads on where a viewer may be allow to view the selected program as many times as desired over a particular time. Russo teaches sending control information "a descriptor" to the user (col.6 lines 12-52, key sent with broadcast to allow decoding, col.7 lines 55-67, keys allowing decoding to only those selected subscribers).

Russo, further fails to explicitly state that the control information is embedded in the broadcast content. The Horton reference is used to show embedding control information into a broadcast stream and further define an action to be taken pertaining to the received content, explicitly storing the received content (col. 3 lines 38-67, 'coded information embedded in the TV signal,' 'indication... of various modes available with this particular program'). Hence the amended claims do not overcome the 103(a) rejection of Russo in

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view of Horton and meets all the claimed limitations. Furthermore appropriate motivation to combine is discussed in the office action. This office action is non-final.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wehrenberg (6,523,113) discloses a method and apparatus for copy protection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', written over a horizontal line.**Annan Q. Shang.**